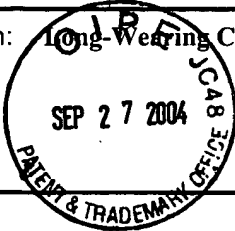


**TRANSMITTAL OF APPEAL BRIEF (Large Entity)**Docket No.  
**97.37US-RCE**In Re Application Of: **Shah**

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
09/248,524	February 9, 1999	Wells, Lauren Q.	NA	1617	NA

Invention: **Long-Wearing Cosmetic Compositions****COMMISSIONER FOR PATENTS:**

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on July 23, 2004

The fee for filing this Appeal Brief is: **\$330.00**

- ☐ A check in the amount of the fee is enclosed.
- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. **05-1320**

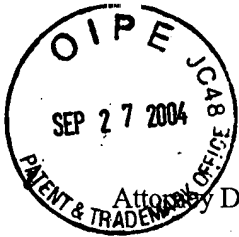
*Signature*Dated: **September 23, 2004**

**Dorene M. Price (Reg. No. 43,018)**  
**Estee Lauder Companies**  
**155 Pinelawn Road**  
**Melville, NY 11747**  
**(631) 414-6087**

I certify that this document and fee is being deposited on **September 23, 2004** with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*Signature of Person Mailing Correspondence***DORENE M. PRICE***Typed or Printed Name of Person Mailing Correspondence*

CC:



Attorney Docket No.: 97.37US-RCE

AP/1617  
PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Shah

Serial No.: 09/248,524

Group Art Unit: 1617

Filed: February 9, 1999

Examiner: Wells, Lauren Q.

For: Long-Wearing Cosmetic Compositions

**APPELLANT'S BRIEF PURSUANT TO 37 CFR 1.191 AND 1.192**

Assistant Commissioner of Patents and Trademarks

Attention: Board of Patent Appeals and Interferences

Washington, D.C. 20231

Dear Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the final rejection of claims 1 to 22 in the present application in the decision of March 23, 2004.

09/28/2004 FMEK11 00000043 051320 09248524

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**REAL PARTY IN INTEREST**

The name of the real party in interest in this appeal is Color Access, Inc., the assignee of the application.

### **RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences relating to the instant application that would directly affect, be directly affected by, or have a bearing of any kind on the Board's decision in this appeal that are known to Appellants.

### **STATUS OF THE CLAIMS**

Claims 1 to 22 remain pending in the application. In Appellants' Amendment mailed June 14, 2004, Claims 1, 10, 19 and 22 were amended. Appellants made another amendment to Claims 1, 10, and 19 in an Amendment mailed November 24, 2003; amended Claims 3, 8, 12, and 20 in an Amendment mailed December 17, 2001; amended Claim 1 in an Amendment mailed December 5, 2000; and amended Claims 1, 5, 10, 14, 16, 18, 19, and 22 in an Amendment mailed June 15, 2000. All pending claims, a copy of which is attached hereto, are included in this appeal.

### **STATUS OF AMENDMENTS**

An Amendment under 37 C.F.R. 1.111, filed on June 14, 2004, was considered, but has been stated, in Advisory Action of July 1, 2004, as raising new issues that would require further consideration and/or search. Further, the Examiner found that there was no support for the amendments made. However, this is due to a typographical error citing page 3, instead of page 5.

## **SUMMARY OF THE INVENTION**

The invention relates to a long-wearing composition comprising an acrylic or methacrylic polymeric component in combination with a water-soluble organic pigment. The compositions are particularly useful as eyeliner, or other eye or skin products. The compositions are water-resistant and stay on as applied. The method of preparing the long-wearing compositions of the present invention comprises the steps of combining the acrylic or methacrylic polymer and the water-soluble pigment. The cited references fail to teach or suggest a combination of an acrylic or methacrylic polymer with a water-soluble pigment.

## ISSUE

The outstanding issue is whether Claims 1 to 22 are rendered obvious by Valdes, et al. (U.S. Pat. No. 4,761,277, hereinafter referred to as “the ‘277 reference”) in view of Alwattari et al. (U.S. Pat. No. 5,874,072, hereinafter referred to as “the ‘072 reference”)? Specifically, the question is whether one of ordinary skill in the art would expect water-soluble organic pigments of the ‘277 reference to be incompatible with the emulsion compositions of the ‘072 reference? Further, due to the incompatibility, would one skilled in the art expect to encounter problems with fading, bleeding, and running of the color due to the use of the water-soluble organic pigment in the emulsion composition? Or, to the contrary, would one of ordinary skill in the art take a water insoluble polymer of the ‘072 reference and add it to the ‘277 reference because the addition would result in compositions having superior wear and that are removable with soap and water?

### **GROUPING OF CLAIMS**

For purposes of determining patentability, Claims 1 to 22, drawn to the sole issue of the present appeal, are grouped together and all grounds of rejection which Appellants contest apply these claims. Specifically, Claims 1 to 22 are grouped together as they apply to the grounds of rejection based on 35 U.S.C. §103(a).

## ARGUMENTS

The outstanding issue is whether Claims 1 to 22 of the present application are rendered obvious by Valdes, et al. (U.S. Pat. No. 4,761,277, hereinafter referred to as “the ‘277 reference”) in view of Alwattari et al. (U.S. Pat. No. 5,874,072, hereinafter referred to as “the ‘072 reference”). The present invention relates to compositions comprising an acrylic or methacrylic acid derived polymeric or copolymeric component in combination with at least one water-soluble organic pigment. In Appellants last Response of June 14, 2004, the claims of the present invention, Claims 1, 10, 19, and 22, were amended to compositions comprising an acrylic or methacrylic acid derived polymeric or copolymeric component in combination with at least one water-soluble organic pigment in a substantially aqueous medium. Support for this amendment was presented as being found in the present specification at page 3, lines 3 to 5. However, this was a typographical error, and the correct citation for support in the present specification is at page 5, not page 3. The compositions of the present invention include any aqueous base or, in other words, any base that is miscible in water, and therefore, a single phase.

The medium of the present invention is substantially aqueous and contains a combination of the water-soluble organic pigment with the polymeric component, for example, an acrylic copolymer like that of the water-insoluble polymer described in the ‘072 reference. The ‘277 reference fails to teach or suggest an acrylic or methacrylic acid derived polymeric component, and the ‘072 reference fails to teach or suggest a water-soluble organic pigment. Appellants traverse the Examiner’s reasoning that one of ordinary skill in the art would add the water-soluble organic pigment of the ‘277 reference to the ‘072 compositions because one of ordinary skill in the art would expect the water-soluble organic pigment of the ‘277 reference to be incompatible with the compositions taught and suggested in the ‘072 reference. Each cited reference is introduced separately, and then Appellants’ arguments regarding the examination of the cited references combination as asserted by the Examiner are provided.

### a. The ‘277 Reference

The Examiner’s obviousness rejection is based on the ‘277 reference for teaching a waterbase lipliner composition in liquid form that comprises a water-soluble organic pigment and a water-soluble organic film-forming polymer. Specifically, the ‘277 lipliner contains a mixture of polyvinyl pyrrolidone and polyvinyl alcohol as a film former. However, the ‘277 reference fails to teach or suggest the polymeric component of the present invention. As discussed in the present specification at page 4, lines 15 to 17, the present invention of long-wearing compositions are

soluble organic pigments in combination with an acrylic or methacrylic acid derived polymer or copolymer. The water-soluble organic pigments of the '277 reference, in contrast to the present invention, are combined with a combination of polyvinyl pyrrolidone and polyvinyl alcohol. Thus, the '277 reference fails to teach or suggest the polymeric component of the present invention.

**b. The '072 Reference**

The '072 reference is cited by the Examiner as a secondary reference for its teaching of mascara compositions comprising water-insoluble polymeric materials in the form of an aqueous emulsion and water-soluble, film-forming polymers. However, the '072 reference teaching of specific organic pigments and lakes is not a teaching of the water-soluble organic pigments of the present invention. Although in column 6, lines 21 to 31, specific organic pigments and lakes of various D&C pigments are provided, the processing steps of the '072 reference, at column 7, lines 6 to 48, teaches that pigments are added to the oil phase with other solid materials that are hydrophobic such as for example, fillers. Specifically, the processing directions for the '072 oil-in-water emulsions, at column 7, line 12, direct that pigments are added to heated waxes and fats along with any other oil dispersible or oil soluble components. Similarly, the '072 water-in-oil emulsions are prepared by dispersing pigments, and any other hydrophobic materials, to the lipophilic phase. This is disclosed in the '072 reference at column 7, lines 39 to 40. The '072 teaching of dispersing the pigment indicates that the '072 pigment is not solubilized. Therefore, the '072 reference fails to teach or suggest the water-soluble organic pigments of the present invention.

In addition, to support limited teaching in the '072 reference of dispersed pigments, Appellants attached with their Response of June 15, 2000 the definition of D&C lakes according to 21 C.F.R. 82.1051 wherein D&C lakes are defined to be made by extending a salt, which is not necessarily water soluble, as the salt extended in FD&C lakes are according to 21 C.F.R. 82.51, on a substrate. Thus, the '072 reference discloses that its pigments are included as a solid in the oil phase of the emulsion composition, and therefore, one of ordinary skill in the art would understand that the pigments of the '072 reference, as they are dispersed and not solubilized, are not the water-soluble organic pigments of the present invention.

The '072 reference teaches ammonium acrylate at column 2, lines 61 to 66 in a section entitled "A. Water-insoluble Polymeric Materials." In this section, the '072 reference teaches that the water-insoluble polymeric materials are added to an emulsion mascara. Presumably, the

water-insoluble polymer is added to an emulsion because it contains at least one compatible phase (i.e., the oil phase). Further, the term emulsion as it is used in the art by one that is skilled is known to include more than one phase and usually the phases include an aqueous and a non-aqueous phase. This is in contrast to a waterbased or substantially aqueous system that has only one aqueous phase. One of ordinary skill in the art would expect the water-insoluble polymers to be compatible with the oil phase of the '072 emulsion mascara. Thus, as the '072 reference fails to teach or suggest that water-insoluble polymeric materials are added to anything else but emulsion mascara compositions, the '072 reference fails to disclose the present invention of a composition containing a water-insoluble polymer in a substantially aqueous medium. In the absence of some teaching, suggestion, or motivation to combine the references, an obviousness rejection cannot depend on a combination of prior art references. *Akamai Technologies Inc. v. Cable & Wireless Internet Services Inc.*, 68 USPQ2d 1186, 1193 (CAFC 2003) (citing *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276 (Fed. Cir. 1987)). The '072 reference, further, fails to teach or suggest the present invention alone or in combination with the '277 reference because neither reference teaches or suggests the incorporation of a water-insoluble polymer in a waterbased composition.

**c. The Combination of the '277 and the '072 References**

The combination of the '277 and the '072 references fails to render the present invention obvious because one of ordinary skill in the art would expect water-soluble organic pigments of the '277 reference to be incompatible with the oil containing compositions of the '072 reference. In order to establish a *prima facie* case of obviousness, it is necessary for the Examiner to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the cited prior art, or in the form of generally available knowledge, that one of ordinary skill in the art would have been led to combine the relevant teachings of the cited references in the manner proposed by the Examiner to arrive at the claimed invention. *Ex parte Levengood*, (BdPatApp&Int 1993) 28 USPQ2d 1300, 1301. If the only suggestion for the Examiner's combination of the isolated teachings of the applied references is derived from Appellant's disclosure, and not from the applied prior art, rejection based on obviousness is improper. *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979).

One of ordinary skill in the art would not add a water-soluble organic pigment of the '277 reference to the '072 reference because the addition would be expected to result in compositions that bleed and/or fade easily. As mentioned in the present specification, despite the

increased desire to use organic pigments in compositions, most, if not all, organic pigments have a tendency to bleed or fade. Further, water-soluble organic pigments have a tendency to run after they are applied to the skin. Attempts to stabilize water-soluble organic pigments have merely resulted in specific solvent systems for specific pigments. This is discussed in the present specification at pages 1 to 2. Thus, one of ordinary skill in the art would not expect to be able to simply take a water-soluble organic pigment as taught in the '277 reference and use it in the compositions described in the '072 reference.

One of ordinary skill in the art would not expect water-soluble organic pigments to be protected in the compositions of the '072 reference. Waxes, oils and fats, and pigments suggested in the '072 compositions are described in the '072 specification at columns 4, 5 and 6. However, in the '277 reference, at column 1, lines 22 to 31, the disadvantages of waxes, and oils, are extolled. Some of the particular disadvantages mentioned include clogging and lack of ability to hold the lipline when lip color is applied. Therefore, ease of application would not be expected, and motivation to combine these two references is not found in the references themselves. In fact, the '277 reference teaches away from such a combination. There is no suggestion to combine if a reference teaches away from its combination with another source. *Tec Air Inc. v. Denso Manufacturing Michigan Inc.*, 52 USPQ2d 1294, 1298 (CAFC 1999)(citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988)).

While not asserted by the Examiner, Appellants assert that one of ordinary skill in the art would not be motivated to substitute the water insoluble pigments of the '072 reference with water-soluble pigments of the '277 reference. At one end of the spectrum, the '072 reference teaches an acrylic polymer containing water insoluble pigments. At the other end of the spectrum, the '277 reference teaches the use of a water-soluble organic pigment in a waterbased system. However, none of the cited references addresses the middle ground, particularly, the water-soluble organic pigment in an acrylic polymer based system. Like oil and water do not mix, one of ordinary skill in the art would not expect water-soluble pigments in anything but water to mix. In other words, one of ordinary skill in the art would not expect the water-soluble organic pigment to be functional unless it was in a waterbased system. Nor would they expect the surprising benefits found with the present invention, namely, protecting the water soluble pigments from running and fading. The combinations of pigments and bases taught in the cited references do not defy logic.

In an opinion rendered in *Gillette Co. v. S.C. Johnson & Son Inc.*, 16 USPQ2d 1923 (CAFC 1990), it was found that water soluble ingredients are not interchangeable with oil

soluble ingredients in an obviousness analysis. In *Gillette*, the gel of the invention at issue used a water-soluble gelling agent while the prior art used an oil-soluble “jellifying” agent. The court in *Gillette*, decided that the results achieved by the new combination, using the water-soluble agent and not the oil-soluble agent, were critical to the analysis of obviousness, and it was determined that the two agents were not interchangeable. As in *Gillette*, the water-soluble pigments of the present invention and the water insoluble pigments of the cited prior art are not interchangeable and one of ordinary skill in the art would not expect them to be interchangeable. Before concluding, the opinion in *Gillette* states “The invention all admired, . . . ; so easy it seemed, once found, which yet unfound most would have thought, impossible!” *Id.* at 1929. Likewise, the present invention and the benefits derived therefrom are not taught or suggested by any of the cited references.

The Examiner has responded that the rejection for obviousness is not based on interchanging ingredients and, Appellants understand that the obviousness rejection is based on adding a water-soluble organic pigment from the ‘277 reference to the ‘072 compounds. However, the difference between “adding” and “interchanging” as it pertains to the obviousness rejection does not change the fact that one of ordinary skill in the art would not expect the ‘277 water-soluble organic pigment to be compatible with the ‘072 compounds.

Appellants also assert that there is no teaching or suggestion in either of the cited references to add a water-insoluble polymer used in an emulsion system (i.e., in the presence of an oil phase) to a waterbased (i.e., in the absence of an oil phase) composition. One of ordinary skill in the art would expect water-insoluble polymers to be compatible with oil and incompatible with water. This expectation is further supported by both the teachings of the ‘072 reference and the ‘277 reference. First, the water-insoluble materials of the ‘072 reference are present in emulsion mascara compositions as mentioned above, and as further demonstrated in the processing directions of the ‘072 reference where the addition of water-insoluble materials to emulsion systems having an oil phase and a water phase is taught. Further still, in each example of the ‘072 reference, regardless of the type of emulsion system (i.e., water-in-oil or oil-in-water,) the water-insoluble materials are added to an emulsion system having an oil phase compatible with the water-insoluble polymeric material. (See examples Processing Directions 1. and 2. at column 7, and Examples 1., 2., and 3. at columns 7 and 8.) Thus, there is no teaching or suggestion in the ‘072 reference to add the water-insoluble materials to a waterbased composition in the absence of an oil phase like the compositions of the ‘277 reference.

Similar to the '072 reference, there is no teaching or suggestion in the '277 reference that a water-insoluble polymer can be added to the '277 waterbased compositions. While the '072 reference fairly teaches that the water-insoluble polymer works in the presence of an oil phase, it is devoid of any mention of how or if the same water-insoluble polymer could work in a waterbased composition. Conversely, while the '277 compositions are waterbased, there is no teaching or suggestion that a water-insoluble polymer can be added to them for any effect. It simply defies logical reasoning to add a water-insoluble polymer to a waterbased composition, and thus, one of ordinary skill in the art would not based on general knowledge nor the cited references make the combination suggested by the Examiner. One of ordinary skill in the art would have no reason to expect the water-insoluble polymer to work similarly, or at all, in a waterbased composition as there is no oil present. Therefore, a *prima facie* case of obviousness has not been made in the present case because one of ordinary skill in the art would not take the water-insoluble polymer of the '072 mascara emulsions and add it to the '277 waterbased compositions.

Finally, the Examiner cites Burdzy (U.S. Patent No. 5,518,728, "the '728 reference") for the premise that eyeliners and lipliners are interchangeable cosmetic product types, at column 10, lines 58 to 65. Essentially at the section cited by the Examiner, the authors recite a number of different forms of cosmetics that the alleged invention can take. There is no indication that any of the forms are intended to be interchangeable as the list includes lipsticks and lip liners, powder products and crème blushes. All that is noted is that the alleged invention can be made in any of the mentioned forms. Further, the '728 reference fails to remedy the defect in the combination of the '277 and the '072 references, namely that there is no motivation to add water-soluble organic pigments to compositions containing water insoluble polymers. Thus, a *prima facie* case of obviousness has not been made and the claims of the present invention are patentable in view of the references cited by the Examiner. Therefore, Appellants submit the claims of the present application satisfy the requirements of 35 U.S.C. §103(a) because the cited references fail to teach or suggest, alone or in combination, a water-soluble organic pigment and a methacrylic or acrylic polymeric component in a substantially aqueous medium, and Appellants request that the Examiner's rejection be withdrawn.

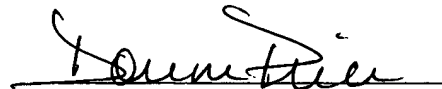
## CONCLUSION

In light of the arguments presented above, the obviousness rejection of Claims 1 to 22 based on the Valdes ('277) reference in view of the Alwattari ('072) reference should be

reversed as they are unfounded. One of ordinary skill in the art would not add the water-soluble organic pigments of the '277 reference to the emulsion compositions of the '072 reference because of the expectation that the water-soluble organic pigments would not be compatible in the '072 emulsion compositions. Accordingly, Appellants respectfully request that the Honorable Board reverse the decision of the Examiner finally rejecting the pending claims and declare that all pending claims in this application are allowable.

Respectfully submitted,

Date: 9/23/04

A handwritten signature in cursive script, appearing to read "Dorene M. Price", written over a horizontal line.

Dorene M. Price, Reg. No. 43,018  
Estée Lauder Companies  
155 Pinelawn Road  
Melville, NY 11747  
(631) 414-6087

## APPENDIX: THE CLAIMS ON APPEAL

1. (currently amended) A long-wearing cosmetic composition comprising a polymeric component selected from the group consisting of an acrylic acid polymer, acrylic acid copolymer, acrylic acid ester polymer, acrylic acid ester copolymer, a methacrylic acid polymer, a methacrylic acid copolymer, a methacrylic acid ester polymer, and a methacrylic acid ester copolymer and at least one water soluble organic pigment in a substantially aqueous medium.
2. (original) The composition of claim 1 wherein said polymeric component is present in an amount of from about 5 to about 95 percent by weight of composition.
3. (previously presented) The composition of claim 2 wherein said polymeric component comprises monomeric elements having 1 to 18 carbon atoms.
4. (original) The composition of claim 3 wherein at least one of said monomeric elements are selected from the group consisting of methacrylate, methylmethacrylate, butylacrylate, and combinations thereof.
5. (previously presented) The composition of claim 1 wherein said polymeric component is ammonium acrylate.
6. (original) The composition of claim 1 wherein said water soluble organic pigment is present in an amount of from about 1 to about 20 percent by weight of composition.
7. (original) The composition of claim 1 wherein said water soluble organic pigment is selected from the group consisting of a natural pigment, a monomeric synthetic pigment, a polymeric synthetic pigment, and combinations thereof.
8. (previously presented) The composition of claim 7 wherein said water soluble organic pigment is selected from the group consisting of FD&C blue No.1, D&C green No. 5, FD&C red No. 40, FD&C yellow No. 5, and combinations thereof.

9. (original) The composition of claim 1 further comprising an inorganic pigment present in an amount of no more than about 1 to about 10 percent by weight of the composition.

10. (currently amended) A long-wearing cosmetic eyeliner or body paint composition comprising: a) from about 5 to about 95 weight % of a polymeric component selected from the group consisting of an acrylic acid polymer, an acrylic acid copolymer, an acrylic acid ester polymer, an acrylic acid ester copolymer, a methacrylic acid polymer, a methacrylic acid copolymer, a methacrylic acid ester polymer, and a methacrylic acid ester copolymer; [and] b) from about 1 to about 20 weight % of at least one water soluble organic pigment; and c) a substantially aqueous medium.

11. (original) The composition of claim 10 wherein said polymeric component is present in an amount of from about 20 to about 50 percent by weight of the composition.

12. (previously presented) The composition of claim 11 wherein said polymeric component comprises monomeric elements having 1 to 18 carbon atoms.

13. (original) The composition of claim 12 wherein at least one of said monomeric elements is selected from the group consisting of methacrylate, methylmethacrylate, butylacrylate, and combinations thereof.

14. (previously presented) The composition of claim 10 wherein said polymeric component is ammonium acrylate.

15. (original) A flow-through cosmetic applicator comprising the composition of claim 1.

16. (previously presented) The applicator of claim 15 wherein said applicator is an eyeliner pen having a nib.

17. (original) A flow-through cosmetic applicator comprising the composition of claim 10.

18. (previously presented) The applicator of claim 17 wherein said applicator is an eyeliner pen having a nib.

19. (currently amended) A method of preparing a long-wearing cosmetic composition comprising combining a polymeric component selected from the group consisting of an acrylic acid polymer, an acrylic acid copolymer, an acrylic acid ester polymer, an acrylic acid ester copolymer, a methacrylic acid polymer, a methacrylic acid copolymer, a methacrylic acid ester polymer, and a methacrylic acid ester copolymer, and a water soluble organic pigment in a substantially aqueous medium.

20. (previously presented) A method according to claim 19 wherein the polymer comprises monomeric elements having 1 to 18 carbon atoms.

21. (original) A method according to claim 20 wherein at least one of the monomeric elements is selected from the group consisting of methacrylate, methylmethacrylate, butylacrylate, and combinations thereof.

22. (currently amended) A method of preparing a long-wearing cosmetic composition for use in a flow-through eyeliner pen having a nib comprising combining an ammonium acrylate copolymer and a water soluble organic pigment in a substantially aqueous medium.